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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,443	02/10/2004	Janusz Rajski	1011-67625	4800
24197	7590	10/06/2004	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			WRIGHT, NORMAN M	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/777,443

Applicant(s)

RAJSKI ET AL.

Examiner

Norman M. Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-73 is/are pending in the application.
- 4a) ~~Of the above~~ claim(s) 1-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/10/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.


NORMAN M. WRIGHT
PRIMARY EXAMINER

DETAILED ACTION

1. The examiner acknowledges the preliminary amendment canceling claims 1-51 and adding new claims 52-73, filed on 2/10/04.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 52-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this instance the claims recite a feature of creating micro-code in non-volatile memory, there does not appear to be any recitation in the disclosure for the creation of a micro-code that is going to be stored in the memory device. The invention does, however, provide support for storing an already created or program in memory as part of the programming of the processor.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 55, 57 and 61 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 61, it attempts to recite a computer readable medium having a computer executable instruction for performing the method of claim 52. As understood by the examiner, this claim is improper. It appears to attempt to define a computer program product as a dependent claim of a method process claim, as such it would fail to limit the method claim. Because a computer program product is an article of manufacture, accordingly, it is a different statutory class. Moreover, the method claims must distinguish over the art of record by the function or process it performs not what it is. Similarly, claims 55 and 57 are structural elements, and fails to further limit the method steps of claim 52. ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 62-64, and 68 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Broseghini et al, U.S. Pat. No. 5,416,783, hereinafter '783.

8. As to claims 62-64 and 68, '783 teaches the claimed invention comprising: apparatus and method for generating pseudo-random test patterns, an integrated circuit, embedded processor, plurality of peripheral devices, means for testing, compacting test responses, plurality of registers, multiplier, adder, accumulator, a test port register, means for moving an n-bit segment, a first accumulator, mean for adding n-bit to a signature value, means for cascading and means for adding to the cascaded

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results (abs., fig. 1-3, 10 elements [12, 20, 24, 73-76 55, 52, 26, 50, 156, 120, 142, 144, 158, 415, 416] col. 3, lines 47-65 et seq., col. 4, lines 30-38 et seq., and lines 60-68 et seq., cols. 5-6, col. 8, lines 12-50 et seq., col. 9, line 42-68 et seq., col. 12, lines 1-15 et seq..

Allowable Subject Matter

9. Claims 71-73 are allowed. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to teach or render as obvious the claimed features of at least one two-dimensional pseudo-random test pattern being utilized in the testing of the integrated circuit.

10. Claims 65-67, and 69-70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to Norman M. Wright at telephone number (703) 305-9586.

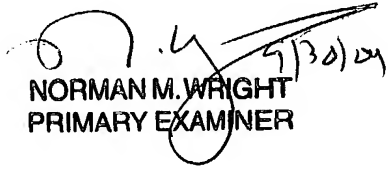
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norman M. Wright whose telephone number is (703) 305-9586. The examiner can normally be reached on Mondays from 8am to 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse, can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

11.


NORMAN M. WRIGHT
PRIMARY EXAMINER